

REMARKS

Claims 1-17 are pending in the present application. Claims 1, 4, 5, 8, 9, 11, 15, 16, and 17 have been amended. Claims 5, 13, 16, and 17 were provisionally withdrawn from consideration, pending the allowance of a generic claim. Support for the claim amendments can be found in the specification, *inter alia*, in paragraphs [0027] – [0031] and the Figures 1-5. Accordingly, applicant respectfully submits that no new matter has been added.

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons which follow.

Claim Rejections Under 35 U.S.C. § 112, second paragraph:

In the Office Action, claims 1-4, 6-12, 14 and 15 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for use of the term “diamond” in the claims.

Applicant’s representative conducted a telephone interview on May 7, 2003, in which this rejection was discussed. Applicant thanks the Examiner for the helpful suggestions made during the interview.

Applicant has amended the claims to now recite “diamond material” in order to clarify the claims. Applicant also points out that a person of ordinary skill in the art would understand the meaning of the term “diamond material” for at least the reasons stated in the reply dated December 26, 2002. Further, even if the claim can be interpreted broadly, the breadth of the claim does not make the claim indefinite. See e.g., MPEP 2173.04. Accordingly, applicant respectfully requests reconsideration of this rejection.

Claim Rejections Under 35 U.S.C. § 102(b)

In the Office Action, claims 1-4, 8-12, 14, and 15 were rejected under 35 U.S.C. §102(b) as being anticipated by Radtke ('618). Applicant respectfully traverses this rejection for the following reasons.

Radtke cannot anticipate the invention recited in claim 1 because Radtke does not disclose "joined shaped parts [that] form a receptacle for holding a specimen, wherein at least one of the shaped parts comprises a diamond material, and wherein the diamond material forms at least part of a first inner surface of the receptacle." (emphasis added)

In contrast, Radtke describes a "drill bit for connection on a drill string" to cut rock and other earth formations, with a body that is hollow inside, not a specimen holder for water-containing specimens for high-pressure freezing, as claimed. While Radtke (col. 5, line 49) discloses a disc shaped diamond cutting element 26, this cutting element is not structured to form "a first inner surface of the receptacle" as claimed. Further, cutting element 26 is placed on an outer edge surface portion by being "bonded on angular supporting surface 24." See Radtke col. 5, line 50, and Figs. 1 and 5A. Radtke's diamond element 26 does not form a receptacle or hold anything; rather element 26 cuts rock and earth formations. Accordingly, applicant respectfully submits that Radtke fails to disclose the recited structure of the claimed specimen holder. For at least these reasons, claims 1-4, 8-12, 14 and 15 are not anticipated by Radtke.

Claim Rejections Under 35 U.S.C. § 103(a)

In the Office Action, claims 1-4, 6-12, 14 and 15 were rejected under 35 U.S.C. §103 as being unpatentable over Radtke. Claims 1-4, 7-12 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kim. Applicant respectfully traverses these rejections for the following reasons.

The deficiencies of Radtke are noted above. In particular, with respect to the rejection under §103, the modification of Radtke that would be necessary to produce the claimed invention would render Radtke's drill bit and nozzle unsatisfactory for its

intended purpose in that Radtke's diamond cutting element 26 would no longer be used for cutting rock and earth formations as intended, but would rather be structured to hold a specimen and be part of an inner surface of the receptacle. As is stated in MPEP 2143.01, "the proposed modification cannot render the prior art unsatisfactory for its intended purpose." This unlikely modification is further evidenced by the fact that Radtke and the present application are directed to completely different areas of endeavor: Radtke's device is for drilling rock and earth formations, while applicant claims a specimen holder with detachably joinable shaped parts (one of which comprises a diamond material) for holding water-containing specimens for high pressure freezing. It follows that Radtke does not address or even hint at the problems being solved by the claimed invention, e.g., the need for freezing a water containing (e.g., biological) specimen using a holder that provides an undiminished cooling rate. See e.g., paragraph [0010]. Thus, for at least these reasons, a person of ordinary skill in the art would not have been motivated to modify Radtke to produce the claimed invention.

Further, the proposed modification of Kim does not yield applicant's claimed invention, as Kim does not teach or suggest "joined shaped parts [that] form a receptacle for holding a specimen, wherein at least one of the shaped parts comprises a diamond material, and wherein the diamond material forms a first inner surface of the receptacle." (emphasis added).

In contrast, Kim describes a three-part container which "is able to securely accommodate a variety of articles" (cf. Col. 1, line 22). Inside of the container a plurality of openings are provided which serve to accommodate, e.g., a "toothbrush, razor blade, tube of toothpaste, etc." and other toiletries, or make-up products, or writing instruments. See Kim, col. 3, lines 23-40. Kim does not address or even hint that the container is or could be modified to be a "specimen holder for water-containing specimens for high-pressure freezing."

Applicant respectfully submits that one of ordinary skill in the art would not have been motivated to modify Kim's portable toiletries or writing instruments container to include diamonds as Kim's object is to provide a container that is "inexpensive" (see

e.g., Kim, col. 1, line 29) to manufacture and the intended personal use of Kim's container does not require the use of such specialized materials.

In order to avoid an improper use of hindsight, the burden lies on the Office to show a motivation to combine references that create the case of obviousness. *In re Rouffet*, 149 F.3d 1350, 1356 (Fed. Cir. 1998). Specifically, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *Id.* The Federal Circuit has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *Id.* None of those possible sources of motivation are found in this case.

Overall, the cited references contain no mention of any of the objects of the present application and are directed to different fields of endeavor. Thus, for at least the reasons mentioned above, applicant respectfully submits that claim 1 is patentable over the cited art. In addition, the dependent claims are also patentable over the cited art for at least the same reasons.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. If claim 1 is allowed, applicant respectfully requests consideration of the previously withdrawn claims and passage of those claims to allowance.

Conclusion

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

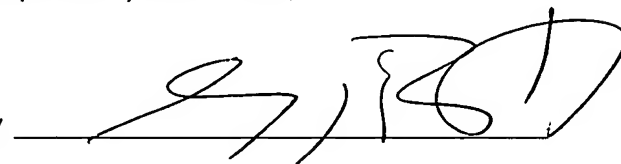
The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date

June 3, 2003

By



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